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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/970,015

10/03/2001

Paul Vegliante

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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/970,015

Applicant(s)

VEGLIANTE ET AL.

Examiner

SEAN M. MICHALSKI

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,11-14,16-23,38-40 and 42-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,11-14,16-23,38-40 and 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Page No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1, 5, 11-14, 17, 20-23, 40,42,43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Urion (4,210,043) and Tsai (5,036,740) as set forth in a previous action (Dated 7/03/2007).

2. Claims 1, 5, 11-14, 20-23, 38-40, 42-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022 and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record thereof as "09741521MA") in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth previously (10/1/09) .

Applicant disputes that Chuang teaches attraction. It is reiterated that examiner has viewed a device according to Chuang, and found that when the plastic film is placed in contact with the rail, there is an attraction therebetween. It is of a minor nature (weak), far less than the *device* of the present application, but enough to meet the claim limitations of "cling properties" and "for attracting ...before, during and after...". The **combination** teaches **the increase** of the ability for the plastic wrap **to cling and be attracted** to the rails, the base reference including some teaching or understanding of motionless and immobilized wrap being cut well. Argument against Chuang alone is not persuasive in this regard, since the combination is informed about the ability to use such

strong cling elements **tape** or the same material class as applicant, as taught by Wankow for the same purpose.

3. Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above and further in view of Union (4,210,043).

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as applied to claims 1, 5, 11-14, 20-23, 38-40, 42-44 above, and further in view of Chiu (US 5,398,576).

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961), Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above, and further in view of Keene (US 3,277,760).

Response to Arguments

6. Applicant's arguments filed 4/1/09 have been fully considered but they are not persuasive.

The arguments related to the rejections of record are not persuasive, since they fail to adequately treat the rejections of record, instead attacking the references individually. Applicant is reminded that "one cannot show non-obviousness by attacking

the references individually where, as here the rejections are based on combinations of references.” In re Keller, 208 USPQ 871 (CCPA 1981).

The additional arguments related to information not found in the declaration is not persuasive, since it is not considered to be evidence but argument. Additionally the affidavit is not sufficient for the burden of proof the applicant bears to establish the alleged facts, as set forth below. The evidence must rise to the standard of “clear and convincing” to overcome the prima facie showing of obviousness (which is a preponderance of the evidence standard).

Applicant disputes that Chuang teaches attraction. It is reiterated that examiner has viewed a device according to Chuang, and found that when the plastic film is placed in contact with the rail, there is an attraction therebetween. It is of a minor nature, far less than the *device* of the present application, but enough to meet the claim limitations of “cling properties” and “for attracting ...before, during and after...”. The **combination** teaches **the increase** of the ability for the plastic wrap **to cling and be attracted** to the rails, the base reference including some teaching or understanding of motionless and immobilized wrap is cut well. Argument against Chuang alone is not persuasive in this regard, since the combination is informed about the ability to use such strong cling elements **tape** or the same material class as applicant, as taught by Wankow for the same purpose.

7. Applicant alleges that the curve appearance of the upper housing has a changed function and thus cannot be rendered obvious by a change to alter the appearance with

no change in function. This is not persuasive, since one of ordinary skill can change the appearance without changing the function and the change would meet the limitation of the claim-- that the form be of a curved nature. Having function that is not recognized by the prior art does not make the change in form non-obvious, please see MPEP 2144 IV.

" The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)" and "*In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991)"

Applicant alleges that examiner is attempting to show obviousness by showing each element was independently known. This is not the case. Examiner has properly considered the prior art according to the broad and flexible approach dictated by the Graham inquiries and affirmed under *KSR International Co. v. Teleflex, Inc.* (550 U.S. - _____ (2007) slip op. at 11)

Applicant alleges that Boda does not disclose the advantages of durable rail and clinging attractive top. This is not persuasive, since applicant is arguing against the references individually, and not the combination. The combination does teach a standard rail (having standard durability) and a layer which provides for the clinging properties as claimed.

Response to Declaration

8. The declaration under 37 CFR 1.132 filed 7/25/2008 is insufficient to overcome the rejection of claims 1, 5, 11-14, 16-24, 38-40 and 42-44 based upon their prima facie obviousness as set forth in the last Office action because:

a. The declaration appears to be trying to establish a showing of commercial success, but fails to establish the **necessary nexus** between the claimed features and the increase in sales/demand. The declaration also fails to quantify, in an appreciable manner and "in a clear and convincing" manner what the change in sales/distribution/demand for products with the specific features of the claim. Specifically, the numbers presented are all estimates, and cite no methodology nor documentary evidence to support the conclusions of "30-50 million" of the slide cutter products. The statement that "AEP moves...3 million pieces" does not establish why those pieces are being moved relative to the "market" in 1998/1999 was 100,000 per year of Conventional cutters. This comparison is additionally flawed, since the "100,000" number comes from AEP alone,(See exhibits A-F; no other conventional cutter numbers from the total market being sought or provided). There is no base 'market' established in the evidence. The affiant states that "Reynolds film...represents about 12 million boxes annually" (with the claimed features of "cling") however since there is no showing of what the Reynolds numbers were prior to the alleged stealing, there can be no showing that the numbers are any different than what would have occurred without the alleged infringement.

b. There appears to be a declaration seeking to show that there has been copying by another (infringement). However, there is no comparison of the pending claim to the accused infringer, nor any *evidence* of duplication. The only comparison is "a very novel cling of plastic wrap"; no conclusion may be drawn as to the pending claims.

c. In element 11 of the declaration, Affiant asserts that the product (as in claim 1) "and duplicates" have penetrated as much as 25 % of the retail sales market. There is no factual evidence to support this assertion in the record. Nor is there any information on how this number was generated. The total number of alleged duplicates (from element 15 of the declaration) is between 30 and 50 million. If this is only 25 % of the market, where is there evidence of 90-150 million total cutting devices of a non-infringing nature. The numbers of estimates are just that-estimates, with no supporting evidence. The allegation that the market has expanded from 100,000 total rail style cutters (flawed due to only citing AEP cutters) to 30 million (flawed at least due to estimation) does not give the kind of probative evidence that is useful in determining the obviousness of the claims at bar.

d. Regarding element 13 of the declaration, the number of countries where alleged "duplicates" of the product defined by the claims at issue are used, is interesting, but there is no evidence to support the conclusion that the accused devices are copied from applicant, or that they infringe on applicant.

Applicant is reminded; from MPEP 716.03 : *Commercial Success >I. < NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED* An applicant who is asserting commercial success to support its contention of nonobviousness **bears the burden of proof** of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating: In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide **hard evidence** of commercial success. In re Huang , 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness). The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

Also from 713 .06(b):

"an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.).

Merely showing that there was commercial success of an article which embodied the invention is not sufficient."

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean M Michalski/
Examiner, Art Unit 3724

/Kenneth Peterson/
Primary Examiner, Art Unit 3724